

REMARKS

Claims 80-82 are canceled. Claims 83-88 are added. Claims 1-79 and 83-88 are in the application for consideration.

The Examiner asserts that it is inherent that Werkhoven et al. results in the formation of a porous oxide because it allegedly uses the same procedure as Applicant's claim 1, and because Applicant attributes porosity to the use of remote plasma nitrogen, and that such is thereby inherent in Werkhoven et al. Applicant again disagrees, and respectfully requests reconsideration.

Specifically, it is not inherent that the processing of Werkhoven et al. would result in the formation of porous oxide, and the fact that Applicant has discovered that use of remote plasma nitrogen can so result does not make it inherent that such occurs in Werkhoven et al.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ 2d 1949, 1950, 1951 (Fed. Cir. 1999).

There is absolutely no disclosure or inference in Werkhoven et al. that a porous oxide is formed. Further, no porous material is shown in the drawings nor is such described anywhere in Werkhoven et al. So, if any inference exists, it is that the oxide formed in Werkhoven et al. is not porous. Even if such may have resulted, such is not necessarily present in Werkhoven et al. and would certainly not be recognized by persons of ordinary skill in the art that it was or that porosity would result.

The Examiner's technical reasoning in support of the conclusion that porosity necessarily flows from the teachings in Werkhoven et al. is Applicant's discovery statement in paragraph [0030] in its specification as-filed. However, the fact that Applicant states in its specification that it discovered something in the context of disclosure of its invention in no way provides adequate basis in fact or technical reason that such must necessarily flow or occur in Werkhoven et al. Applicant's discovery of something in no way means that such inherently occurs in the processing and teachings of a prior art reference. The missing descriptive matter as respects porosity is not necessarily present in Werkhoven et al. and even if such might have occurred, it would not be recognized by persons of ordinary skill as required pursuant to the above authority.

For the foregoing reasons, it is respectfully asserted that the Examiner's anticipation rejection over Werkhoven et al. with respect to Applicant's independent claim 1 should be withdrawn, and action to that end is requested.

Applicant's independent claims 44 and 68 also recite the formation of porous oxide (claim 44) or porous aluminum oxide (claim 68). Such claims are rejected over Werkhoven et al. However, such reference is inapplicable for the reasons asserted above with respect to claim 1, and the rejection thereover should be withdrawn. Action to that end is requested.

Claims 80-82 are canceled without any admission as to the propriety of the Examiner's rejection of such claims.

Dependent claims 83-88 are added. Claims 83, 85, and 87 recite that the contacting is effective to form the porous oxide to have substantially closed-cell pores. Claims 84, 86 and 88 recite that the contacting is effective to form the porous oxide to be of about 50% porosity. Support for the same can be found in Applicant's specification as-filed in paragraph [0043]. Accordingly, no new matter is added. Under no conceivable stretch of the imagination does Werkhoven et al. disclose such. Further, it is virtually inconceivable that it is inherent in Werkhoven et al. that either substantially closed-cell pores are formed, or that the resultant oxide is of about 50% porosity. Accordingly, claims 83-88 should be allowed as reciting non-inherent features in Werkhoven et al. in addition to the assertions above that the respective claims from which such depend are not anticipated or obvious over Werkhoven et al.

Applicant's remaining dependent claims should be allowed as depending from allowable base claims, and for their own recited features

which are neither shown nor suggested in the cited art. Action to that end is requested.

This application is believed to be in immediate condition for allowance.

Respectfully submitted,

Dated: 8-13-07

By: 

Mark S. Matkin
Reg. No. 32,268